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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,757	05/15/2006	Kyung Yang Park	71503.0006	3555
57362 7590 02/02/2009 AKERMAN SENTERFITT 801 PENNSYLVANIA AVENUE N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER				
AHMED, MASUD				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/563,757

**Applicant(s)**

PARK, KYUNG YANG

**Examiner**

MASUD AHMED

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8506)
- Paper No(s)/Mail Date 1/9/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

A preliminary amendment to the claims were submitted on 1/9/2006 is considered by the examiner along with an amendment to the specification submitted on 2/21/2006.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-2, 4- 6, 8-16, and 18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Walker et al (US 6, 890,256).**

**Regarding claims 1 and 15**, Walker teaches a system and method for advertising in a networked slot machine having following limitations:

An advertisement generating server generates the advertisement to provide to the service provider of the slot machine (FIG 2, 7 and col 3, lines 39-43);

Ad server provides the advertisement selected by the user (col 4, lines 39-49);

Slot machine server constitutes the advertisement to be displayed on the slot machine (col 4, lines 60-67);

A registered user receives the slot machine game and the advertisement via the coupled server network (col 5, lines 20-39),

Walker is silent on disclosing mixing of the advertisement in a literal term, however a close analysis of the applicant's claim word "mixes" merely states among the various advertisement criteria the selected advertisement is displayed upon player's selection, therefore from the disclosure of Walker in the summary teaches the various advertisement and product information is displayed to the player's upon their selection and the previous characteristics of the players, therefore it would have been obvious to ordinary skilled artisan at the time of invention to mix and match player's advertisement preference for better product marketing.

**Regarding claim 2**, Walker teaches the ad generating server classifies the advertisement according to the contents and identifier (col 3, lines 39-43), Walker further teaches the advertisement display frequency controller that controls the exposure frequency of the advertisement within the slot machine (col 4, line 42).

**Regarding claims 4 and 18**, Walker teaches players having a player tracker ID that corresponds to the certain player's activities on the gaming machine, based upon the activities they are given certain products or services via slot machine free of charge (col 2, lines 52-57), which is an alternative way of compensating player for being a registered player.

**Regarding claim 5**, Walker teaches the membership management server that keeps track of player's compensation points (another word for cyber money), winnings and various characteristic data's (col 2, lines 52-53).

**Regarding claim 6**, Walker teaches certain types advertisement or certain products and services are offered to the players upon their winning of the wagering machine at a discount (col 3, lines 52-59), which is an alternative to the offering players cyber money.

**Regarding claims 8-9**, Walker teaches players having a player tracker ID that corresponds to the certain player's activities on the gaming machine, based upon the activities they are given certain products or services via slot machine free of charge (col 2, lines 52-57), further Walker teaches certain types advertisement or certain products and services are offered to the players upon their winning of the wagering machine at a discount (col 3, lines 52-59), the merchandise database on FIG 2 stores the products information and the products that can be purchased, therefore considered to be a cyber

shopping mall and players can shop considering having a credit balance in their account.

**Regarding claims 10-13**, Walker teaches his system can be online or the product information can be downloaded into the slot machine locally, machines can be also connected via an wireless network (col 1, lines 53-57, col 4, lines 33-36), therefore it can be concluded from the disclosure that the machine can be played locally or off-line and can be connected to the server as necessary for the player's win.

**Regarding claim 14**, Walker teaches the server communicates with the user terminal bi-directionally and provides question to answer (col 3, lines 22-25), where server ask the users, whether they want to purchase certain products or services, adding an ad quiz to compensate players, is within the knowledge of ordinary skilled artisan.

**Regarding claim 16**, Walker teaches displaying the advertisement within the slot machine, therefore mixing the advertisement page with the slot machine interface.

**4. Claims 3, 17, 21-24 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Walker et al (US 6, 890,256), in view of Walker et al (US 2002/0151366), hereon Walker '366.**

**Regarding claims 3 and 17,** In addition to the claim 1, Walker teaches various advertisements is showing on various slot machines based on the bet amount, however Walker is silent on disclosing players having an option to choose their winning ratio. It is well known in the art of wagering games that the higher numbers of probabilities given to the players that bet higher amount of money as an option, thus Walker'366 teaches a system and method of playing slot machine online where player can select their own winning ratio (summary), or a higher incremental pay based on the agreeing to the advertisement (col 6, lines 3-7), therefore it would have been obvious to ordinary skilled artisan at the time of invention to include higher wagering option in exchange for higher winning ratio in the game for the better revenue for the casinos as well as higher winning for the players.

**Regarding claims 21-24,** Walker teaches the player device to be a wireless; However Walker is silent on disclosing player device being a cellular phone where player can receive the information on certain products offered by the advertisement. Walker'366 teaches the an online wagering system having player device as a cellular phone and gives player option to customize the product preferences to receive product and service information, such as physical work (replacing the roof, a new insurance policy etc), further the player can decline the offers made by the server and continue on gambling (para 0101), therefore it is understood from the disclosure of Walker'366 that the services or the products that bought through the server will be delivered or provided to the corresponding physical location or the player's stored address, therefore it would

have been obvious to ordinary skilled artisan at the time of invention to include a cellular phone to Walker's system as a part of player's device to wager and receive advertiser's information about the products and services anywhere as opposed to casinos.

**Claims 7, 19-20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Walker et al (US 6, 890,256), in view of Gonen et al (US 2003/0199313).**

**Regarding claims 7,** Walker teaches money transfer to a bank or establishment from the player account (col 5, lines 56-58), however silent on disclosing money or credit or cyber money transfer from player to player. It is understood from the disclosure of Walker that if the fund can be transferred to an outside establishment, it would have been within the knowledge of ordinary skilled artisan to transfer money within the gaming establishment and to another registered member. Gonen teaches an online wagering game where players can transfer fund among each other (para 0053), therefore it would have been obvious to ordinary skilled artisan at the time of invention to modify Walker's system to make it compatible to transfer funds, points, comps to the other registered users within the system to have the freedom of trades among players.

**Regarding claim 19,** Walker teaches the player having player tracker ID that identifies the player track record of winnings, characteristics etc, However Walker is silent on disclosing other players ID to be entered in the system for the automatic funds transfer to the other user's account. Gonen as disclosed above teaches the funds transfer to the



other users account, further Gonen teaches each users account identification is automatically stored (para 0070).

**Regarding claim 20**, Walker teaches players having a player tracker ID that corresponds to the certain player's activities on the gaming machine, based upon the activities they are given certain products or services via slot machine free of charge (col 2, lines 52-57), further Walker teaches certain types advertisement or certain products and services are offered to the players upon their winning of the wagering machine at a discount (col 3, lines 52-59), the merchandise database on FIG 2 stores the products information and the products that can be purchased, therefore considered to be a cyber shopping mall and players can shop considering having a credit balance in their account.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MASUD AHMED whose telephone number is (571)270-1315. The examiner can normally be reached on Mon-Fri 10:00am-7:00pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571 272 4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714

/M. A./  
Examiner, Art Unit 3714